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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,249	03/14/2001	Joseph P. Steiner	06843.0036-00000	1312

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EXAMINER	
KIM, VICKIE Y	

ART UNIT	PAPER NUMBER
1614	19

DATE MAILED: 09/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/805,249	STEINER ET AL.	
	Examiner	Art Unit	
	Vickie Kim	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6,7,11-14,25,26,28,29,33,34,36,37,41,42,44 and 45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *See Continuation Sheet* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1-4,6,7,11-14,25,26,28,29,33,34,36,37,41,42,44 and 45.

DETAILED ACTION

Election acknowledged

Applicants affirmation on the election with traverse of Group V, claims 1, 2, 11, 41-42 and 44-45 and the species, example 11 compound, is acknowledged. Applicant's partial traversal is persuasive. Thus, the restriction requirement is withdrawn and supplemental restriction/election of species requirement is issued as following:

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-4, 6-7, 12-14, 25-26, 28-29, 33-34 and 36-37 drawn to a method of treating a neurological activity in an animal comprising administering to said animal an effective amount of a compound having of formula I.

   II. Claims 1, 11, 41-42 and 44-45 , drawn to a method for stimulating neurite outgrowth by a nerve cell comprising administering to said nerve cell an effective amount of a compound having of formula II.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are patentably distinct if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, they requires different modes of operations(e.g. routes of administration to the animal(other than nerve cell(not necessarily nerve cell)) *vs* to the nerve cell) or they have different effects, for example, treating a neurological

activity(e.g. preventing neurological degeneration or treating neurological disorder) is different from stimulating neurite outgrowth by a nerve cell.

Because these inventions are distinct for the reasons given above and the search required for each group is not same, wherein a reference which anticipates the invention of Group I would not render the invention of Group II obvious, absent ancillary art, restriction for examination purposes as indicated is proper.

Election/Restrictions

3. Previously, the subject matter of the invention of group II(current) and compound 11 as the elected species was elected(previously found in group V, now withdrawn). If applicant likes to keep the previous election of the subject matter that is newly regrouped into the group II(current), applicant is not required to respond to the election of species requirement.

4. However, if group I is elected, upon the election of the patentably distinct invention of the group, applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

The group I, claims 1-4, 6-7, 12-14, 25-26, 28-29, 33-34 and 36-37 are subject to the election of species requirement as following:

Claim 1 that is directed to a method of treating a neurological activity is generic to a plurality of disclosed patentably distinct species comprising stimulation of damaged neurons, promotion of neuronal regeneration, prevention of neurodegeneration, or treatment of neurological disorder. The species are recited in claims 2. Applicant is

required to elect a single disclosed species(e.g. specific examples in the specification), from under the instant claims of the elected group.

Moreover, whatever specific species is ultimately elected, applicants are required to list all claims readable thereon.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. Applicant's election of species(example 11 compound) was acknowledged. In response to applicant's traversal based on the ground that the claimed species are not patentably obvious variant, the examiner withdrew the election of species(for single compound not a method mentioned immediately above). As admitted by applicant, Since any single species (compound) claimed is not considered to be patentably obvious variant, it is noted that any reference anticipates the claimed species(single compound), will be used against all the claims having generic formula I.

Conclusion

5. All the pending claims are subjected to the restriction/election requirement.

6. The instant office action supercedes any previous office action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is 703-305-1675.

The examiner can normally be reached on Tuesday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on 703-308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-3165 for regular communications and 703-746-3165 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Vickie Kim,
Patent examiner
September 2, 2003
Art unit 1614